

## REMARKS

### A. Claims 15-17, 20, 23-30, and 34-45 Are Definite

The Office states that “[c]laims 15 and 34 call for a method but it is not clear exactly what this method is and hence these claims and those dependent thereon are indefinite. Applicant should properly recite exactly what the method is designed to produce for clarity of the claims.” Applicants respectfully traverse.

This rejection is virtually identical to the one the Office issued in August 21, 2008 Office Action, which was successfully traversed in Applicants’ December 22, 2008 response:

The claimed method covers the recited steps; if those steps are performed, the claimed method is met. There is no legal requirement that Applicants use a more descriptive or word-intensive preamble in order to satisfy section 112 because the body of the claims sets forth all of its limitations. *See* MPEP 2111.02. Moreover, there is no evidence that one of ordinary skill in the art would have any trouble understanding what Applicants have claimed when claim 15 is read in light of the specification.

December 22, 2008 response at page 6. Applicants respectfully submit that the present rejection is overcome for the same reasons. *See also Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) (“The test for definiteness under the second paragraph of 35 U.S.C. § 112 is whether **‘those skilled in the art’** would understand what is claimed when the claim is read in light of the specification.”) (emphasis added).

The Office also contends that the recitation “as soon as possible” in claim 34 is vague. That language has been deleted.

### B. Claims 15-17, 20, 23, 26-38 and 41-45 Are Patentable over the Asserted Combination

Claims 15-17, 20, 23, 26-38 and 41-45 stand rejected as being obvious over JP 10-146846 in view of US 6,416,689 (Keita) or US 5,662,839 (Magne), and further in view of US 4,440,918 (Rice). Applicants respectfully traverse.

## **I. Independent Claim 15**

None of the cited references discloses or suggests the claimed rotating, which involves approximately 90 degrees of rotation but also rotation **about a horizontal axis passing through the portion of the mold.** The only rotating the Office relies on is Rice's, and Rice fails to specify whether the referenced 180 degrees of rotation was about a horizontal or vertical axis. Moreover, the referenced 180 degrees of rotation was more likely to have occurred **about a vertical axis rather than the claimed horizontal axis** because it occurred during UV radiation from an RS sunlamp placed 18 cm away. *See* col. 11, lines 32 – 40; *see also* col. 9, line 39 – col. 10, line 9 (discussing the use of photoinitiators and UV radiation in polymerization). It would have made sense to expose one face (front or back) of the contact lens to the UV radiation for a period of time and then expose the opposite face (back or front) of the contact lens to the UV radiation.

In addition, given that it would not be possible to accomplish such exposure (i.e., one face and then the other) **without rotating a full 180 degrees.** the claimed 90 degrees of rotation is not obvious.

For each of these reasons, claim 15 is not obvious over the asserted combination.

As a third reason, claim 15 has also been amended to recite that the claimed rotating occurs “prior to any polymerizing of the polymerizable composition[.]” Rice's rotation occurred **only after** 5 minutes of polymerization through exposure to UV radiation occurred. Accordingly, none of the references teach or suggests this claimed subject matter, and claim 15 is patentable over the asserted combination for at least this additional reason.

The obviousness rejection of claim 15 and its rejected dependent claims should be withdrawn.

## **2. Independent Claim 31**

Independent claim 31 and its dependent claims are patentable over the asserted combination for at least the same reasons as independent claim 15, and the rejection of them should be withdrawn.

## **3. Independent Claim 34**

Independent claim 34 and its dependent claims are patentable over the asserted combination for at least the same reasons and independent claim 15, and the rejection of them should be withdrawn.

## **C. Claims 24, 25, 39 and 40 Are Patentable over the Asserted Combination**

Claims 24, 25, 39 and 40 stand rejected as being obvious over JP 10-146846 in view of either Keita or Magne, and Rice, and further in view of US 2004/0021238 (Reed). Claims 24 and 25 depend from claim 15, and claims 39 and 40 depend from claim 34. Claims 15 and 34 are patentable over the Japanese reference, Keita or Magne, and Rice for the reasons provided above. Reed fails to cure their deficiency. Accordingly, claims 24, 25, 39 and 40 are patentable over the asserted combination for at least the same reasons, and Applicants therefore respectfully request withdrawal of the rejection.

**D. Conclusion**

The pending claims are in condition for allowance. The Examiner is invited to contact Applicants' representative at the number below with any questions or suggestions.

Respectfully submitted,

/Mark T. Garrett/

Mark T. Garrett  
Reg. No. 44,699  
Attorney for Applicants

FULBRIGHT & JAWORSKI L.L.P.  
600 Congress Avenue, Suite 2400  
Austin, Texas 78701  
(512) 536-3083

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